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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,808	03/08/2001	Andrew D. Firlik	337348020US1	8272

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EXAMINER

BRADFORD, RODERICK D

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 12/17/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,808

Applicant(s)

FIRLIK ET AL.

Examiner

Roderick Bradford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 124-167 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 164-167 is/are allowed.
- 6) ☒ Claim(s) 124-126, 131-146 and 150-163 is/are rejected.
- 7) ☒ Claim(s) 127-130 and 147-149 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 9, 10, 14. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species 1 of Group II in Paper No. 13 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 124-126, 131, 132, 136-145, 150, 151 and 155-164 are rejected under 35 U.S.C. 102(b) as being anticipated by Schiff et al. U.S. Patent No. 5,938,688.

Referring to claims 124, 125, 131, 136, 140, 143, 144, 150, 155, 159 and 162

Schiff discloses a method of stimulating the brain of a patient to effectuate a neural function comprising:

- Providing an image of neural activity in the cortex of the brain of the patient (Figs 2A-2E)
- Selecting a stimulation site comprising a region of the cortex of the brain of the patient where a change in neural activity is expected to occur to carry out the neural-function (column 11, lines 39-46)
- Applying electrical signal directly to the stimulation site, wherein the signal has a voltage of less than 10V (column 7, line 7-10), a frequency less than

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approximately 1000Hz (column 6, lines 24-26), and a pulse width less than approximately 100ms (column 6, lines 24-26).

Referring to claims 126 and 145, wherein applying the electrical stimulation to the stimulation site comprises a signal having a voltage of approximately 50mV to 5V directly to the stimulation site (column 7, line 9).

Referring to claims 132 and 151, further comprising applying the electrical stimulation directly to the stimulation site by implanting an electrode proximate to the cortex of the patient and aligned with the stimulation site (column 5, lines 62-67).

Referring to claims 137 and 156, wherein applying the electrical stimulation to the stimulation site comprises applying a signal having a frequency of less than approximately 200 Hz (column 7, line 11).

Referring to claims 138, 139, 157 and 158, wherein applying the electrical stimulation to the stimulation site comprises applying a signal having a frequency of approximately 40-200Hz and 50-100Hz (column 7, line 11).

Referring to claims 141, 142, 160 and 161, wherein applying the electrical stimulation to the stimulation site comprises applying a signal with a pulse width of less than about 200 μ s and a pulse width of less than 100 μ s (column 7, line 12).

Referring to claim 163, further comprising performing behavioral therapy on the patient related to a body part controlled by the particular neural-function while applying the electrical signal directly to the stimulation site (Table 2).

Referring to claim 164, wherein the patient has an impaired function because of a loss of the particular neural-function and the method further comprises performing

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physical therapy on a body part of the patient controlled by the particular neural-function while applying the electrical signal directly to the stimulation site (column 14, lines 21-55).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 133-135 and 152-154 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff et al. U.S. Patent No. 5,938,688.

Referring to claims 133-135 and 152-154, Schiff discloses the claimed invention except for wherein the electrode is placed in direct contact with the pial surface or placed at the dura or placed in contact with dura of the brain of the patient. It would have been obvious to one having ordinary skill in the art at the time the invention was

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made to modify the method as taught by Schiff to include wherein the electrode is placed in direct contact with the pial surface or placed at the dura or placed in contact with dura of the brain of the patient since it was well know in the art that placing the electrode on the pial surface or at dura on the brain or in contact with the dura as means of stimulating different part of the brains as to treat different ailments.

Allowable Subject Matter

7. Claims 165-167 are allowed.

8. Claims 127-130 and 147-149 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Bradford whose telephone number is (703) 305-3287. The examiner can normally be reached on Monday - Friday 7 a.m. - 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

R. Bradford
R.B.

Angela D. Sykes
ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
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